



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/773,891

02/06/2004

Andrew R. Ferlitsch

SLA1444

8258

50735

7590

12/11/2007

MADSON & AUSTIN

15 WEST SOUTH TEMPLE

SUITE 900

SALT LAKE CITY, UT 84101

EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

12/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,891	<b>Applicant(s)</b> FERLITSCH, ANDREW R.	
	<b>Examiner</b> CHAN S. PARK	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**DOUGLAS Q. TRAN**  
**PRIMARY EXAMINER**

*Trans*                      *Chan S. Park*

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/10/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5, 11, 14, 15, 22, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 recites the limitation "wherein the rendering is initiated at a printer" in line 1. There is insufficient antecedent basis for this limitation in the claim. Furthermore, it is unclear if this rendering is referring to the rendering of the document for the printing. Also, it appears that the rendering of the document is processed at the computer device. How is the rendering process initiated by the printer? Is this printer same as the printing device recited in the rest of the claim? Explanation/clarification from the Specification is respectfully requested.
2. With respect to claims 14 and 22, arguments analogous to those presented for claim 1, are applicable.
3. With respect to claim 5, it further defines that the plurality of print option comprises standard options and proprietary options. It is unclear if both standard and proprietary options are sent to the computing device according to claims 4 and 5. Explanation/clarification from the Specification is respectfully requested.
4. Claim 11 recites the limitation "associated with the document format to background print" in line 2. There is insufficient antecedent basis for this limitation in

the claim. It is unclear if this document format is referring to a native/original document format or the rendered document format. Explanation/clarification from the Specification is respectfully requested.

5. With respect to claims 15 and 23, arguments analogous to those presented for claim 11, are applicable.

6. With respect to claim 14, it recites the limitation "receiving the document after it has been rendered by the computing device" in line 10. It is unclear if the original document (un-rendered document) is received according to this step.

Explanation/clarification from the Specification is respectfully requested.

7. Claim 14 recites the limitation "the printer" in last line. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this printer is referring to the printing device or another printer in the network.

8. With respect to claim 22, it recites the limitation "receiving the document after it has been rendered by the computing device" in line 13. It is unclear if the original document (un-rendered document) is received according to this step.

Explanation/clarification from the Specification is respectfully requested.

9. Claim 24 recites the limitation "the identification" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leone, III et al. U.S. Patent Publication No. 2004/0100651 (hereinafter Leone) in view of Garcia U.S. Patent Publication No. 2003/0048470.

10. With respect to claim 1, Leone teaches a method for pull printing a document wherein the rendering is initiated at a host computer (browser 44 of client computer in figs. 4~8), the method comprising:

locating a document (application server storing documents in paragraph 18) on a computer device (locating the document in the application server 30 using the job ID in paragraph 34) from the host computer (specifying the job parameters via the browser in paragraphs 33 & 34);

sending a message to the computer device to print the document with at least one print option (sending required parameters in paragraphs 33 & 34);

rendering the document at the computer device into printer ready data using the at least one print option thereby providing a rendered document (paragraphs 35~36);

de-spooling the rendered document to the printing device (step 90 in fig. 10 & paragraph 35);

processing another print option on a printing device (performing according to staple or collation options in paragraph 33. Note that one of ordinary skill in the art would recognize the step of stapling is conventionally processed at the printer itself); and

printing the rendered document on the printing device (paragraph 36).

Leone, however, does not explicitly teach that the step of locating the document on a computer device is from the printing device.

Garcia, the same field of endeavor of the Internet network printing, teaches the method of a printing device accessing network servers using an embedded web browser (fig. 3 & paragraphs 16 & 17).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the embedded web server into the printing device to access and download the desired document directly from the application server.

The suggestion/motivation for doing so would have been to put the control of printing documents at the printer itself rather than a computer workstation (paragraph 17 of Garcia).

Therefore, it would have been obvious to combine Leone with Garcia to obtain the invention as specified in claim 1.

11. With respect to claim 2, the combination teaches the method of claim 1, further comprising specifying the at least one print option from the printing device after the document has been located (paragraph 33 of Leone and paragraphs 16 & 17 of Garcia).

12. With respect to claim 3, the combination teaches the method of claim 2, wherein the specifying is accomplished through use of a front panel of the printing device (User interface 20 in fig. 1 & paragraph 15 of Garcia).

13. With respect to claim 4, the combination teaches the method of claim 1, wherein the message is sent to the computer device with a plurality of print options (paragraphs 33 of Leone).

14. With respect to claim 5, the combination teaches the method of claim 4, further comprising determining which of the plurality of print options are standard print options on the computer device (Note that Postscript specifies layout, font, and etc. for the printing process. Therefore, paragraphs 33 & 36 of Leona determines the standard print options) and which of the plurality of print options are proprietary to the printing device (staple function & output media characteristics in paragraph 33. As note above, the staple function and output media characteristics are realized and performed by the printing device itself).

15. With respect to claim 6, the combination teaches the method of claim 5, further comprising storing the proprietary print options on the printing device (Note that the staple print processing parameter and output media characteristics must be first saved either permanently or temporarily in a memory/buffer of the printing device upon selecting the option via the printer user interface 20 in fig. 1. If it is not saved, the function will never be recognized and processed.)

16. With respect to claim 7, the combination teaches the method of claim 6, further comprising storing an identification of the document on the printing device (Again, since

user specifies the document ID according to paragraph 34 of Leone, the information must be saved either permanently or temporarily in a memory/buffer of the printing device).

17. With respect to claim 8, the combination teaches the method of claim 6, wherein the message is sent to the computer device to print the document with the standard print options and wherein the document is rendered at the computer device into printer ready data using the standard print options (paragraph 36 of Leone).

18. With respect to claim 9, the combination teaches the method of claim 1, further comprising storing an identification of the document on the printing device (Again, since user specifies the document ID according to paragraph 34 of Leone, the information must be saved either permanently or temporarily in a memory/buffer of the printing device).

19. With respect to claim 10, the combination teaches the method of claim 1, wherein the document is rendered at the computer device into printer ready data that is compatible with a page description language interpreter (paragraph 36 of Leone. Note that Postscript is one of PDL).

20. With respect to claim 11, the combination teaches the method of claim 1, further comprising invoking an application on the computer device that is associated with the document format to background print the document using a generic printer driver (paragraphs 30 & 36). Note that it is conventionally well known that the background specification is defined in the PDL or Postscript file for printing.



21. With respect to claims 12 and 13, the combination teaches the method of claim 8, further comprising recognizing the rendered document at the printing device through use of the identification (paragraph 20 of Garcia) and fetching the stored proprietary print options (note that the fetching the proprietary print options is an inherent step to perform the process according to the designated proprietary print options).

Furthermore, according to Garcia, it teaches the method of simply retrieving the desired document from the file server/document database in the network (paragraph 24).

Therefore, when other proprietary print options are desired for the printing the document, it would have been obvious to one of ordinary skill in the art to 1) identify the retrieved document with the proprietary print options and 2) merge the retrieved document with the proprietary print options for suitable printing.

22. With respect to claim 14, Leone discloses a computer (client computer in paragraph 27 & figs. 4~8) configured for pull printing a document wherein the rendering is initiated at the computer (browser 44), the computer comprising:

- a processor for control of the computer (CPU);

- memory in electronic communication with the processor (memory needed for processing the client computer);

- a communications port for electronic communications with a computing device (application server 30 in figs. 4~8);

a user interface (browser 44) for operating the printing by a user, wherein the user interface is in electronic communication with the processor for receiving user inputs (specifying the job parameters via the browser in paragraphs 33 & 34); and

executable instructions executable by the processor (paragraph 32), wherein the executable instructions are configured to implement a method comprising:

providing a user interface at a display for the user to locate a document on the computing device (locating the document in the application server 30 using the job ID in paragraph 34);

obtaining print options from the user (specifying the job parameters via the browser in paragraphs 33 & 34), wherein the print options comprise standard print options that are standard on the computing device (Note that Postscript specifies layout, font, and etc. for the printing process. Therefore, paragraphs 33 & 36 of Leona determines the standard print options) and proprietary print options that are proprietary to the printing device (staple function & output media characteristics in paragraph 33. As note above, the staple function and output media characteristics are realized and performed by the printing device itself);

storing the proprietary print options (Note that the staple print processing parameter and output media characteristics must be first saved either permanently or temporarily in a memory/buffer of the printing device upon selecting the option via the printer user interface 20 in fig. 1. If it is not saved, the function will never be recognized and processed);

storing an identification of the document (Again, since user specifies the document ID according to paragraph 34 of Leone, the information must be saved either permanently or temporarily in a memory/buffer of the printing device);

sending a message to the computing device to print the document with the standard print options (paragraphs 35~36);

receiving the document after it has been rendered by the computing device, wherein the rendered document comprises printer ready data (paragraph 36);

merging the proprietary print options with the rendered document before the rendered document is printed (note that the staple function & output media characteristics in paragraph 33 must be fetched and merged to print the document according to the designated user input); and

printing the rendered document using a printer (paragraph 36).

Leone, however, does not explicitly teach that the step of locating the document on a computer device is from the printing device.

Garcia, the same field of endeavor of the Internet network printing, teaches the method of a printing device accessing network servers using an embedded web browser (fig. 3 & paragraphs 16 & 17).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the embedded web server into the printing device to access and download the desired document directly from the application server.

The suggestion/motivation for doing so would have been to put the control of printing documents at the printer itself rather than a computer workstation (paragraph 17 of Garcia).

Therefore, it would have been obvious to combine Leone with Garcia to obtain the invention as specified in claim 14.

23. With respect to claim 15, arguments analogous to those presented for claim 11, are applicable.

24. With respect to claims 16 and 17, arguments analogous to those presented for claims 12 and 13, are applicable.

25. With respect to claim 18, the combination discloses the printing device of claim 16, wherein the message sent to the computing device to print the document with the standard options is sent to a pull print service running on the computing device (paragraphs 27 & 36 of Leone).

26. With respect to claim 19, the combination discloses the printing device of claim 14, wherein the document, at the time the user locates the document on the computing device, is in a native document format and has not been pre-rendered into printer ready data (paragraph 36).

27. With respect to claim 20, arguments analogous to those presented for claim 5, are applicable.

28. With respect to claim 21, the combination discloses the printing device of claim 14, wherein the identification of the document includes a filename (paragraph 34 of Leone).

29. With respect to claim 22, arguments analogous to those presented for claim 14, are applicable.
30. With respect to claim 23, arguments analogous to those presented for claim 11, are applicable.
31. With respect to claims 24 and 25, arguments analogous to those presented for claims 12 and 13, are applicable.
32. With respect to claim 26, arguments analogous to those presented for claim 18, are applicable.
33. With respect to claim 27, arguments analogous to those presented for claim 19, are applicable.
34. With respect to claim 28, arguments analogous to those presented for claim 5, are applicable.


**Conclusion**

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

csp  
November 27, 2007

  
DOUGLAS Q. TRAN  
PRIMARY EXAMINER

Chan S. Park  
Examiner  
Art Unit 2625

